



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,163	03/04/2002	Kathleen Hickey Wallis	530057-332	6026
33717	7590	07/13/2004	EXAMINER	
GREENBERG TRAUIG LLP 2450 COLORADO AVENUE, SUITE 400E SANTA MONICA, CA 90404			MOHANDESI, JILA M	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/091,163

**Applicant(s)**

WALLIS, KATHLEEN HICKEY

**Examiner**

Jila M Mohandesi

**Art Unit**

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

### A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16-24, 27 and 38-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 27, 38, 40 and 42 is/are rejected.
- 7) ☒ Claim(s) 14, 16-24, 39, 41 and 43-46 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 14 is objected to because of the following informalities: In claim 14, line 2, "1.5 inch in breath" appears to be --5 inch in breath--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-10, 12 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weavers (5,568,863). Weavers '863 discloses a substantially rectangular foldable case (10) for displaying an object (cassette 26), the case comprising: first and second case sections joined by a flexible spine (spine 18) to form an integral body, the first and second case sections (base 12 & cover 14) each having a well for receiving an object such that the case sections can be foldably closed with the object inside; the flexible spine permitting a first turning action to the first case section along an axis generally parallel to a first major side of the flexible spine; the flexible spine permitting a second turning action to the second case section along an axis generally parallel to the second major side of the flexible spine; a cutout portion in the first case section and/or second case section; and an at least partially transparent window attached over the cut out portion on the first and/or second case section. See

Figures 2 and 3 embodiments and column 2, lines 58-63 and column 3, lines 29-34 and column lines 3-7.

With respect to the size of the foldable case, Weavers '863 in column 3, lines 3-10 discloses that the size of the foldable case can be modified to accommodate different cassettes of varying format. Therefore, it would have been an obvious matter of design choice to modify the shape and size of the foldable case to accommodate varying size cassettes, since such a modification would have involved a mere change in the size and shape of a component. A change in size and shape is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) and *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

With respect to the location and number of the cutout portion with a transparent window, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide additional cutout portions with transparent windows in different parts of the foldable case to better view the contents of the foldable case, since it has been held that mere duplication and rearranging of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8 and *In re Einstein*, 8 USPQ 167.

With respect to claims 8-9 note the transparent window (transparent external pocket wrap 28) attached over the cut out portion (window 20') of the spine 18, in Figures 1-3 embodiments.

With respect to claims 10, 12 and 24-26 and the material of the transparent window and display box, see column 4, lines 61-65.

The foldable case of Weavers '863 is inherently capable of storing a toy.

4. Claims 11, 38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weavers '863 in view of Leverence (2,619,168). Weavers '863 as described above disclose all the limitations of the claims except for the transparent window being a meshed screen. Leverence '168 discloses that it is desirable to provide a mesh screen to a window opening to permit ventilation without the admission there into of unwanted objects. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a mesh screen to the window opening of Weavers '863 as taught by Leverence '168 to allow ventilation without the admission there into of unwanted objects into the foldable case.

5. Claims 1, 3-10, 12 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blanco (5,839,575). Blanco '575 discloses a foldable case (10) for displaying an object (booklet 80, floppy disk 84, compact disk 82), the case comprising: first and second case sections joined by a flexible spine (binding member 14) to form an integral body, at least one of the first and second case sections (tray 18 and tray 20) having a well for receiving an object such that the case sections can be foldably closed with the object inside; the flexible spine permitting a first turning action to the first case section along an axis generally parallel to a first major side of the flexible spine; the flexible spine permitting a second turning action to the second case section along an axis generally parallel to the second major side of the flexible spine; a cutout portion in the first case section; and an at least partially transparent window (viewing window 86)

attached over the cut out portion on the first case section. See Figure 2 embodiment and column 2, lines 58-63.

With respect to the size of the foldable case, it would have been an obvious matter of design choice to modify the shape and size of the foldable case to accommodate varying size cassettes, since such a modification would have involved a mere change in the size and shape of a component. A change in size and shape is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955) and *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

With respect to the location and number of the cutout portion with a transparent window, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide additional cutout portions with transparent windows in different parts of the foldable case to better view the contents of the foldable case, since it has been held that mere duplication and rearranging of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8 and *In re Einstein*, 8 USPQ 167.

With respect to claim 13 and 42 and the shape of the cut out portion, it would have been an obvious matter of design choice to modify the shape of the cut out in the foldable case to match the items being held therein, since such a modification would have involved a mere change in the shape of a component. A change in the shape is generally recognized as being within the level of ordinary skill in the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

Art Unit: 3728

6. Claims 11, 38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blanco '575 in view of Leverence (2,619,168). Blanco '575 as described above discloses all the limitations of the claims except for the transparent window being a meshed screen. Leverence '168 discloses that it is desirable to provide a mesh screen to a window opening to permit ventilation without the admission there into of unwanted objects. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a mesh screen to the window opening of Blanco '575 as taught by Leverence '168 to allow ventilation without the admission there into of unwanted objects into the foldable case.

7. Claims 2, 13, 26 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blanco '575 in view of Becker et al. (4,597,743). Blanco '575 discloses all the limitations of the claims except for the foldable case including a booklet that is a toy. Becker '743 discloses that it is desirable to make booklets as toys to make them more pleasing to the children. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a toy booklet instead of the booklet of the foldable case of Blanco '575 as taught by Becker '743 to make the foldable case and booklet more pleasing to the consumer.

***Allowable Subject Matter***

8. Claims 14, 16-24, 39, 41, 43 and 45 would be allowable if rewritten or amended to overcome the objection, set forth in this Office action.

9. Claims 44 and 46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M Mohandesi whose telephone number is (703) 305-7015. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

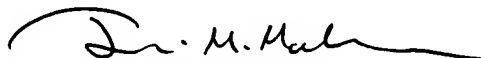
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Art Unit: 3728

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**JILA M. MOHANDESI**  
**PRIMARY EXAMINER**



Jila M Mohandesi  
Primary Examiner  
Art Unit 3728

JMM  
July 09, 2004